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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,731	04/09/2001	Marc Alaia	46700-5004-12	8904

7590 12/26/2002
Daniel H. Golub
1701 Market Street
Philadelphia, PA 19103

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,731

Applicant(s)

ALAIA ET AL.

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/9/2001 and pre-amendments.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89,92-99,102-115,117-125,128,129 and 138-162 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 89,92-99,102-115,117-125,128,129 and 138-162 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.5 6) ☐ Other: _____

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DETAILED ACTION

1. This office action is in response to application filed 4/9/2001 as a continuation of application 09/311,557 (Now Patent 6,216,114).

2. Claims 89, 92-99, 102-115, 117-125, 128-129 and 138-162 are pending following the preliminary amendments filed Nov. 9 2001 and Oct. 7, 2002.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

4. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 89, 92-99, 102-115, 117-118, 138-150 and 159-162 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) *that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts"* (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. Applicant is requested to consult USPTO, Board of Patent Appeals and Interferences ruling Ex Parte Bowman, 61 USPQ2d 1669 (Unpublished) decided June 12, 2001.

The aforementioned claims recite a method to control overtime in an electronic auction. However, steps (a)-(c) fail to recite any technological implementation. Mere stating "electronic auction" and reciting "electronic network" does not cure this deficiency in light of the 112(second) deficiency (see below).

Specification

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in claims 149 and 152. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Refer to analysis of claims 149 and 157 provided under 35 USC § 112 (first) below.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 149 and 157 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

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connected, to make and/or use the invention. Claims 149 and 157 are not supported by specification in that per Fig. 7A- 9B for example do not support claim limitation "the first time interval" not equal to "the second time interval".

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 89, 92-99, 102-108 and 159-160 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. As an example of the cited deficiency, claim 89 is discussed. Similar analysis also applies to independent claim 99. Dependent claims inherit deficient of respective parent claims.

Claim 89 recites "wherein an auction sponsor and at least one bidder are coupled electronically over a communication network during the auction". This limitation has no relationship to any other limitation recited in the claim and therefore renders the claimed invention(s) indefinite.

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Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

14. Claims 89, 92-99, 102-108, 138-162 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Newsbyte, (Excite calls Online Auctions, June 10, 1998) (hereafter Newsbyte).

Claim 89: News byte discloses a method to control overtime in an overtime auction (online auction - tile), comprising:

(a) defining a first time interval ..during which bids are submitted ("..between three and fourteen days including "the final ten minutes", assumed now on that this is 3 days), a second time interval (the auction is extended in "ten-minute increments", the second time interval amounts to 3 days plus 10 minutes (one increment)), a first overtime condition (any bidding occurring in the final ten minutes), and a first closing time..(3 days after the start of the auction), first time interval not being equal to the second time interval (first time

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interval is 3 days, the second time interval is 3 days and 10 minutes);

(b) determining whether the first overtime condition occurs during the first time interval (any bidding occurring in the final ten minutes of the first time interval);

(c) extending the first closing time using the second time interval in accordance with the determination (the "initial" closing time of 3 days is extended by second time interval to 3 days and 10 minutes);

wherein the auction sponsor and ..bidder are coupled over a communication network (Excite auction is "online" excite being a sponsor);

wherein the first closing time corresponds to an end of the first time interval if the first closing time is not extended in step (c) (first time interval is 3 days which is the first closing time), and ... corresponds to an end of the second time interval if first time interval is extended (auction is closed in 3 days plus 10 minutes if extended).

Claim 92. second time interval varies during the auction (the auction is extended in 10 minute increments, however, at the discretion of the auctioneer this may be changed to any other time amount).

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Claims 93-98: (exemplary analysis) overtime extension is triggered if the submitted bid is better than a current best bid.. (any bidding occurring in the final ten minutes inherently considers various factors recited in the present claims. A person of skilled in the art would appreciate that a plurality of conditions are appropriate for triggering extension of the auction because the purpose of the auction is to optimize the administration of auction in consideration of time constraints and providing for maximum benefit to the sellers).

The Newsbyte fails to explicitly disclose various criteria for triggering the overtime extension stated in claims 94-97. It would have been an obvious matter of design choice to apply one or more condition related to the submitted bid (within a predetermined amount of another bid as an example per claim 95) or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine such knowledge with the relevant teachings of the cited reference.

All limitations of claims 99 and 102-108 have been analyzed as in corresponding method claims 89 and 92-97.

All limitations of claims 138-145 have been analyzed in claims 89,92-98 and 159-162 as discussed previously.

Per claim 146, the second time interval (3 days + 10 minutes) extends to a second closing time (start time plus (3

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days + 10 minutes) instead of 3 days from the start) further comprises:

Defining a third time interval (third time interval = 3 days + (2 times) 10 minutes), a fourth time interval (fourth time interval = 3 days + (3 times) 10 minutes) a second overtime condition..(any bidding occurring in last ten minutes of any interval), the third time interval not being equal to the fourth ..(this is obvious from the above explanation);

Determining whether the second overtime condition occurs during the third time interval (the auction is extended in ten-minute increments in response to any bidding occurring in the final ten minutes);

Extending the second closing time by the fourth time interval in accordance with the second determination (the second closing time 3 days plus 10 minutes from the start of the auction is extended to further 10 minutes and so on).

Per claims 147-150 Newsbyte teaches all limitations of claim 147, 148 and 150. Note that first time interval is 3 days, second time interval is 10 minutes before scheduled closing and second time interval is 10 minute, which is extension time.

All limitations of claim 150 are analyzed as per claim 146.

Per claim 151 Newsbytes discloses a machine-readable medium for controlling overtime in an electronic auction..to

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Define an overtime triggering interval..(final ten minutes), an extension time interval (ten minute increments), an overtime condition (any bid arrives) and a closing time ..(between three and fourteen days)..;

Determine whether the overtime condition occurs during the overtime triggering interval (any bidding occurs in the final ten minutes);

Extending the closing time using the extension time interval..(the auction is extended in ten-minute increments).

Claim 152. refer to analysis of claim 151 above.

Claim 153. "any bidding occurs" include limitation amount of bid as per claim 153 and "bid is submitted by an incumbent supplier".

Claims 155, 157 and 158 have been analyzed per claims 151 and 147-149 as above.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 109-115, 117-125 and 127-129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newsbyte as applied to claims above, and further in view of Godin et al. (US Pat. 5,890,138).

Claims 109-115, 117-125 and 127-129 concern displaying an updated closing time in an electronic auction. Newsbyte, does not explicitly teach displaying information about bid status and closing time, including updated closing time. In the same field of endeavor, however, Godin teaches a computerized, network based auction system (Fig. 1) where information pertinent to the auction including auction time information (see for example Fig. 10 which shows auction time related information). It would have been obvious to one of ordinary skill in the art at the time of the invention to display information as disclosed by Godin, pertinent to auction status per teachings of Newsbyte in the

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context of the stated auction method including closing time including update closing time based on time extension because the displayed information would inform the bidders status regarding the auction status and closing time for their bidding decisions.

Claims 110-117 and 120-128 are analyzed as in corresponding method claims 92-96.

Claim 129 has been analyzed as in claims 109 and 119.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address

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for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th

Floor, Alexandria VA 22202.


Jagdish N. Patel

(Examiner, AU 3624)

12/23/02